

***THIS OPINION WAS NOT WRITTEN FOR PUBLICATION***

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FREDERICK A. GILES  
and CHARLES W. GLANCY

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Appeal No. 95-1148  
Application 07/873,345<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 57.<sup>2</sup>

We have carefully considered the record before us, and based thereon, find that we cannot sustain any of the grounds of rejection under 35 U.S.C. § 102 or § 103 over each of Smith

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<sup>1</sup> Application for patent filed April 21, 1992. According to appellants, this application is a continuation of application 07/540,174, filed June 19, 1990 now abandoned.

<sup>2</sup> Specification, pages 30-37, and amendment of April 21, 1992 (Paper No. 13).

et al.,<sup>3</sup> Floyd et al. and Hoy et al.<sup>4</sup> We do so even though we recognize that the record before us can be considered to be incomplete.<sup>5</sup>

As a simple matter of claim construction, the water-borne, water-reducible or water-dispersible coating compositions as claimed must contain a specific nitrogen-containing compound falling within the Markush recitation which defines these compounds. *See generally In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). In the same manner, the claimed methods of making coating compositions require the addition of a specific nitrogen-containing

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<sup>3</sup> Smith et al. and the other references relied on by the examiner with respect to the grounds of rejection are listed at page 3 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

<sup>4</sup> The examiner has withdrawn the grounds of rejection based on the *Union Carbide Product Information Bulletin* (RD 65-2) (answer, page 2).

<sup>5</sup> The examiner's answer (Paper No. 20) does not fully set forth an explanation of the grounds of rejection on appeal including the two *new grounds* of rejection based on Hoy et al. which were not so identified. See 37 CFR § 1.193(a) (1993); MPEP §§ 1208 and 1208.01. The examiner set forth a statement of each of the six grounds of rejection only under section "(4) Issues" and not under section "(9) Grounds of rejection" or section "(10) New grounds of rejection" in the answer (pages 2-4). Under the latter sections, there was no explanation of any of the grounds of rejection as the examiner merely pointed to certain portions of Smith et al. and Floyd et al., but not Hoy et al., with respect to the "recitation of limitations for claim 1" and portions of all three references with respect to the "recitation of limitations for claim 36" in section "(9) Grounds of rejection." Indeed, no prior office action was even identified as providing an explanation for any ground of rejection. Thus, the extent of the explanation provided as to any of the grounds of rejection in the answer is found in the discussion of appellants' arguments in section "(11) Response to argument" (pages 4-9). The stated grounds of rejection of claims 12 through 20 and 29 through 57 under § 102 over Hoy et al. and of claims 20 through 57 under § 103 over Hoy et al. (answer, page 2) constitute *new grounds* of rejection since in the final rejection (Paper No. 16; pages 4 and 5), Hoy et al. was relied on to reject only claims 12 through 20 under § 102 and claims 20 through 35 under § 103. Furthermore, even though appellants argued the grounds of rejection over Hoy et al. as stated in the final rejection, the examiner responded as if these grounds of rejection encompassed claim 1 (answer, pages 7-8). Since appellants did not, of course, argue the rejections of claims 29 through 57 under § 102 and of claims 36 through 57 under § 103 over Hoy et al. in their brief, the examiner provided no explanation with respect to the thus newly rejected claims. Appellants did not submit a reply brief with respect to the new grounds of rejection and the examiner did not require one. See 37 CFR 1.193(b); MPEP §§ 1206 (1200-7), 1208 (1200-15) and 1208.01. Because we can dispose of this appeal based on the record before us, in the interest of prosecution economy we will not require that these formal and procedural matters be addressed.

compound. This requirement for the inclusion of a defined nitrogen-containing compound is the same in all of the appealed claims, including claims 1 and 21 which are drawn in “Jepson” format. *See generally In re Fout*, 675 F.2d 297, 299-301, 213 USPQ 532, 535-36 (CCPA 1982); *In re Ehrreich*, 590 F.2d 902, 904, 200 USPQ 504, 510 (CCPA 1979). Thus, the claims require a complete water-borne, water-reducible or water-dispersible coating composition containing a specific nitrogen compound and a method of making such a composition by adding a specific nitrogen compound to an otherwise complete water-borne, water-reducible or water-dispersible coating composition. *See Exxon Chemical Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555-58, 35 USPQ2d 1801, 1802-05 (Fed. Cir. 1995)(“Consequently, as properly construed, Exxon’s claims are to a composition that contains the specified ingredients at any time from the moment at which the ingredients are mixed together.”).

In comparing the entire disclosure of Smith et al. and Floyd et al. with the appealed claims as we have construed them above, it is readily apparent that the coating compositions prepared in these references do not contain a nitrogen containing compound as specified in the appealed claims and thus clearly do not anticipate these claims. It is well settled that in making out a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claims, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984). Indeed, in Smith et al., the disclosure pointed to by the examiner (answer, pages 3-4) involves the 2-*hydroxypropyl maleate ester* of 2-hydroxyethylene ethylene urea, which nitrogen containing compound falls outside the defined group of nitrogen containing compound in the appealed claims and is not *per se* included in the paint composition since it is copolymerized to form a vinyl acrylic latex that is then used in the composition (see cols. 3 and 4). Similarly, in Floyd et al., the urea compounds pointed to by the examiner (answer, pages 3-4), are reacted with glyoxal to form blocked glyoxal resins which are contained in binder additives for paper coating compositions (see, e.g., col. 2, lines 23-33, col. 3, lines 1-9 and 19-20, and Examples I, II, VI and VII). With respect to the grounds of rejection under § 103 based on Smith et al. and on Floyd et al., we cannot conclude that the claimed invention as a whole would have been *prima facie* obvious since

the record does not contain objective teachings or suggestions in the applied prior art taken as a whole and/or evidence of knowledge generally available to one of ordinary skill in the art which would have led that person to modify the coating compositions and methods of making the coating compositions taught in these references in order to arrive at the claimed invention of using a specified nitrogen containing compound *per se* in the coating composition without recourse to the teachings in appellants' disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 1074-1076, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chemical*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

Turning now to the grounds of rejection based on Hoy et al. (*see supra* note 5), while we agree with the examiner that the reference teaches coating compositions containing a thermosetting resin and a nitrogen containing compound as specified in the appealed claims and are disclosed to have good gloss<sup>6</sup> (e.g., Hoy et al. Example 4, pages 7-8), we do not find that this reference anticipates or conclude that this reference would have rendered obvious *any* of the claims on appeal. There are a number of differences between the claimed coating compositions or methods of making these compositions and the coating compositions of Hoy et al. First, *all* of the claims on appeal specify that the coating compositions are water-borne, water-reducible or water-dispersible. However, it is clear that the coating compositions disclosed in Hoy et al. require the "use of nearly non-volatile substituted ureas as reactive diluents and reactive

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<sup>6</sup> With respect to appellants' argument that the property of enhanced gloss recited in the appealed claims distinguishes over Hoy et al. (brief, page 10), we note that it is well settled that the recitation of a new property with respect to a claimed product or method does not establish the patentability of an otherwise anticipated or obvious product or process. *See, e.g., In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990); *In re Spada*, 911 F.2d 705, 707-08, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782-83, 227 USPQ 773, 779 (Fed. Cir. 1985).

cosolvents together with an organic volatile solvent to form the liquid vehicle for the application of film forming polymers” (col. 1, lines 6-10; see also, e.g., col. 6, line 46, and col. 7, lines 16-58). Thus, the disclosed compositions of Hoy et al. do not satisfy the claim limitation that the composition be water-borne, water-reducible or water-dispersible. Second, appealed claims 21 and 29, and claims dependent thereon, as well as appealed claims 2, 13, 37 and 48, require “thermoplastic” and not “thermosetting resins.” Thus, the disclosed compositions of Hoy et al. do not satisfy the claim limitation requiring “thermosetting resins” found in the cited appealed claims. And, third, appealed claims 12 and 29, and claims dependent thereon, further require the presence of “a pigment component” which is not provided for in Hoy et al. Thus, the reference does not satisfy each and every limitation of the appealed claims, *King, supra*; *Lindemann Maschinenfabrik, supra*, and the record does not contain objective teachings or suggestions in the applied prior art taken as a whole and/or evidence of knowledge generally available to one of ordinary skill in the art which would have led that person to modify the non-pigmented, thermosetting resin and organic solvent containing coating compositions and methods of making such coating compositions taught in Hoy et al. in order to arrive at the claimed water-borne, water-reducible or water-dispersible coating compositions of the appealed claims. *See, e.g., Vaeck, supra*; *Warner, supra*.

The examiner's decision is reversed.

*Reversed*

JOHN D. SMITH  
Administrative Patent Judge

CHUNG K. PAK  
Administrative Patent Judge

CHARLES F. WARREN  
Administrative Patent Judge

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